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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,990	04/19/2004	Bryan M. Buchi	3053.2.1	3498

7590 04/05/2006  
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EXAMINER

DEVOTI, PAUL D

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,990	<b>Applicant(s)</b> BUCHI, BRYAN M.	
	<b>Examiner</b> Paul Devoti	<b>Art Unit</b> 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/19/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-11, drawn to Group I, classified in class 52, subclass 107.
- II. Claims 12-20, drawn to Group II, classified in class 52, subclass 746.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product, a liner, could be used in a different process other than covering a window well.

3. During a telephone conversation with Mr. Michael Starkweather on March 27, 2006 a provisional election was made with traverse to prosecute the invention of Group 1, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “cap” recited in claim 4, line 2 and claim 7, line 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1-5 recite the limitation "window well liner". There is insufficient antecedent basis for this limitation in the claims.

8. Claim 1, line 3 ("a second side configured to contact a window well") recites the window well as intended use. Claim 1, line 4, however, ("the window well liner is configured to attach to the window well") positively recites the window well. It is unclear whether claim 1 is directed towards a liner per se, or a combination of a liner and a window well.

9. Regarding claim 5, lines 1-2 ("the window well liner is secured to the window well with screws") positively recite the window well. It is unclear whether claim 5 is directed to a liner per se, or a combination of a liner and a window well.

10. Regarding claim 6, lines 1-2 ("the screws pass through the liner and into a proud section of the window well") positively recite the window well. It is unclear whether claim 6 is directed to a liner per se, or a combination of a liner and a window well.

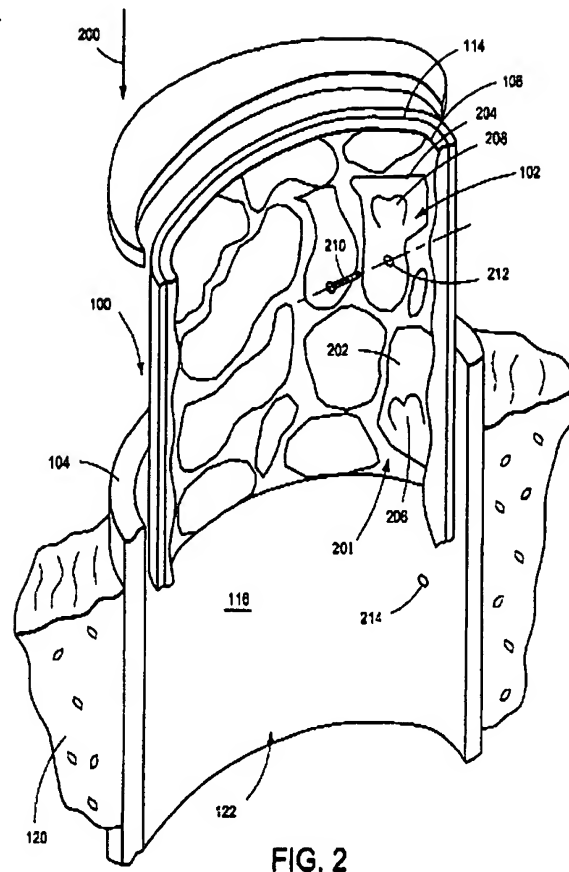
***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Bryant et al. (US 2004/0035063).
13. Regarding claim 1, Bryant discloses a window well shield assembly (100) including a window well (104) and a shield (102). The window well shield (102) has a first side (106) with a three dimensional pattern (108) that protrudes therefrom, and a second side (114) capable of contacting and attaching to a window well (104).
14. Regarding claim 2, the first side (106) comprises a pattern of artificial rocks (108).
15. Regarding claims 5 and 6, the window well shield (102) is secured to a window well (104), with screws (210) that pass through the liner (106, 114) and into the window well (104).



Bryant et al. (US 2004/0035063) Figure 2

***Claim Rejections - 35 USC § 103***

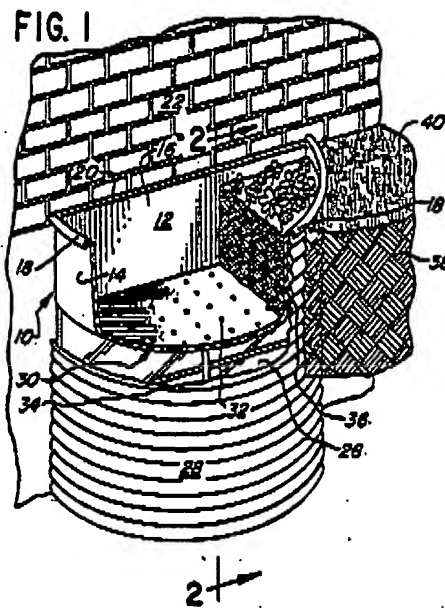
16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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17. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US 2004/0035063) in view of McGinnis (US 4896467).

18. Bryant discloses everything previously mentioned, but does not disclose a cap engaging the top edge of the window well shield (102) and top edge of the window well (104). McGinnis, however, discloses a window well cover with a cap (18) that engages the top of the well cover (14) and the top edge of the window well (28). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Bryant's window well shield to include a cap that engages the window well shield and the window well, as taught by McGinnis to secure the covering to the window well.



McGinnis (US 4896467) Figure 1



19. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US 2004/0035063).

20. Regarding claim 3, Bryant discloses everything previously mentioned, but does not disclose the window well shield is comprised of polyurethane. It would have been obvious to one having ordinary skill in the art at the time of invention to make the window well shield of polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

21. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US 2004/0035063) in view of McGinnis (US 4896467).

22. Regarding claim 8, Bryant in view of McGinnis discloses everything previously mentioned, but does not disclose the window well shield is comprised of polyurethane. It would have been obvious to one having ordinary skill in the art at the time of invention to make the window well shield of polyurethane, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

23. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US 2004/0035063) in view of McGinnis (US 4896467).

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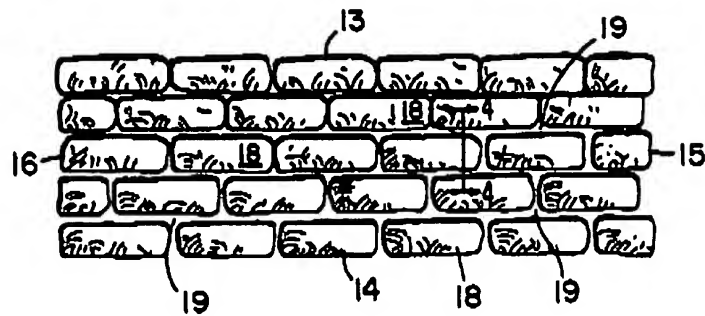
24. Regarding claim 11, Bryant in view of McGinnis discloses everything previously mentioned, including screws (210) that pass through the liner (106, 114) and into the window well (104).

25. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US 2004/0035063) in view of McGinnis (US 4896467).

26. Regarding claim 9, Bryant in view of McGinnis discloses everything previously mentioned, including the pattern is a series of round and elliptically shaped rocks (108).

27. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US 2004/0035063) in view of McGinnis (US 4896467) as applied to claim 7 above, and further in view of Rygiel (US 6237294).

28. Regarding claim 10, Bryant in view of McGinnis discloses everything previously mentioned, but does not disclose that the pattern is a series of generally rectangular shaped rocks. Rygiel, however, discloses a decorative panel (10) with rectangular shaped bricks (18). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Bryant's window well shield, already modified by McGinnis, to include a pattern with rectangular shaped rocks, as taught by Rygiel to have a molded panel with a desired pattern.



**FIG. 3**

Rygiel (US 6237294) Figure 3

### **Conclusion**

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Groves (US 5647154) discloses a decorative window well shield to be placed along an inner wall of a window well, and which is held in place with clips that secure the top surface of the liner and the top surface of the window well. Wellnitz (US 2308131) discloses a window well lining for the inner wall of a window well. Sherry (US 5787666) discloses a thin masonry panel that gives the appearance of stone-like or masonry-like elements. Salazar (US 4644719) discloses a decorative wall panel with a reinforcing layer and a patterned top layer.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Devoti whose telephone number is 571-272-2733. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PD *PD*  
03/31/06

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